

REMARKS

Claims 1-44 are presently pending. Claims 25-44 were withdrawn from consideration. In the above-identified Office Action, Examiner withdrew previous rejections of Claims 1-24 and presented new rejections in view of newly cited Mitchell et al. (US 2003/0149661 A1, herein after Mitchell). Claims 1-11 and 15-24 were rejected under 35 USC 102(e) as being anticipated by Mitchell. Claims 12-14 were rejected under 35 USC 103(a) as being unpatentable over Mitchell in view of Kipp (U.S. Patent No. 5,239,167).

By this Amendment, certain minor edits were made to the claims. For example, the phrase "and authorizing said financial transaction" was deleted from Claim 15 to avoid confusion between the second means and a clearing house. In addition, the phrase -- and wherein said second means does not require participation of a clearing house-- was added to Claim 16 to further clarify that the operation of the second means, as disclosed in the Specification, is independent of the operation of a clearing house or database associated therewith. Any added limitations were already inherent in the claims.

By this Amendment, Applicant further argues in favor of the rejected Claims 1-24. For the reasons set forth below, the present Application is submitted as properly defining an invention patentable over the prior art. Reconsideration, allowance, and passage to issue are respectfully requested.

Rejections Under 35 U.S.C. 102(e)

The invention is set forth in claims of varying scope. Claim 1 is illustrative. Claim 1 recites:

1. A system for facilitating transactions comprising:
a charging terminal for charging an account based on an account number;
a scanner for obtaining biometric information; and
first means for employing said biometric information to automatically provide an account number to said charging terminal. (Emphasis added.)

In rejecting Claim 1 under 35 U.S.C. 102(e), Examiner suggests that Mitchell discloses a payment management system (100) that includes a charging terminal (EFTPOS terminal in [0002]), a scanner (fingerprint reader in Fig. 1), and a POS/ATM ([0023]-[0024] and [0007]-[0008]) that disclose the invention of Claim 1.

However, Mitchell neither teaches, discloses, nor suggests a mechanism for employing biometric information to automatically provide an account number to a charging terminal. The system of Mitchell does not teach retrieval of an account number to a charging terminal and certainly does not teach automatic retrieval of an account number to a charging terminal. Instead, Mitchell teaches sending a biological identifier, such as a fingerprint, to a clearing house for processing ([0023]). The biological identifier must be processed at the clearing house (e.g. [0052]). Instead of providing an account number back to the charging terminal, the clearing house sends the merchant either a confirmation of acceptance of the transaction or information indicating that the transaction was declined (last portion of [0052] of Mitchell). Biometric data employed in the invention as claimed is not used to determine approval of a transaction by a clearing house, but instead is employed to retrieve a credit card number or other relevant numbers to a charging terminal. This results in significant benefits not anticipated by the art of record, as discussed more fully below.

Furthermore, note that any transfer of account numbers or biometric data taught in Mitchell is not automatic. For example, the system of Mitchell requires additional user input at the Point Of Sale (POS), which may exacerbate checkout lines ([0049]-[0050]). For example, Mitchell teaches user selection of one or more accounts associated with a unique biological identifier at the POS ([0049]), and further suggests that at the time of a transaction, the merchant will ask the customer whether the customer wishes to use a credit, debit card, or fingerprint credit card ([0050]). After first manually entering which type of transaction is to be employed, the user must then place their finger on the reader and then manually nominate which account is associated with the customer's fingerprint, and then subsequently manually press the "OK" button (last portion of [0050]). Certainly, the process taught or anticipated Mitchell does not involve automatic retrieval

of account information to a charging terminal. Instead, Mitchell teaches non-automatic transfer of an account number or biometric data from POS to a clearing house, not from another entity to a POS.

Mitchell at most discloses a system that employs a biological identifier to authenticate a user for a particular credit card or to use the biological identifier in place of the credit card. In both cases, the clearing house processes information pertaining to the biological identifier. Unfortunately, implementation of the system of Mitchell requires participation of each participating clearing house. Consequently, if a relevant clearing house does not adopt or participate in the system of Mitchell, Mitchell may not be implemented or may be periodically in applicable depending upon which clearing house is employed for a given transaction. This represents a serious disadvantage that is overcome by the invention as claimed.

The system of Mitchell exhibits various significant shortcomings when compared to the invention as claimed, as discussed more fully below. For example, unlike the invention as claimed, the system of Mitchell requires additional user input at the POS and, consequently, is unlikely to increase checkout lines at merchant outlets.

Hence, Mitchell does not teach, disclose, or suggest automatic retrieval of credit card data via a biometric as claimed in Claim 1. Mitchell requires manual manipulation, and account numbers are not retrieved at all. Account numbers are certainly not automatically retrieved.

Since Claim 1 as amended is not taught, disclosed, or suggested by Mitchell, the corresponding dependent Claims 2-14 are also necessarily not taught, disclosed, or suggested by Mitchell. Nevertheless, the following discussion of the rejections pertaining to each claim further exemplifies how the Claims distinguish over the art of record.

Regarding Claim 2, Examiner suggests that Mitchell further discloses the first means as a credit card or Automated Teller Machine (ATM) terminal, wherein the account number includes a credit card number and expiration date or an ATM number and Personal Identification Number (PIN) ([0023]-[0024] of Mitchell) as recited in Claim 2.

However, note that Mitchell does not disclose retrieval of any data, and certainly not data such as a PIN. For example, the user must provide the PIN when using the embodiment of Mitchell that employs a PIN [0057]. Such entry of a PIN by a user should not be considered automatic retrieval as claimed. Such an embodiment would likely require manual user input and cumbersome navigation of a POS interface, which could delay checkout lines. Furthermore, users often forget PINs, making use of PINs as disclosed in Mitchell problematic when compared with the invention as claimed. Similarly, Mitchell clearly does not teach, disclose, or suggest use of a credit card expiration date as claimed. Hence, Mitchell does not employ biometric information to automatically provide, deliver, or send an account number, including an ATM and PIN or a credit card number and expiration date, to a charging terminal as recited in Claim 2. Hence, the invention as recited in Claim 2 is clearly neither anticipated by Mitchell nor is obvious in view thereof.

Regarding Claim 3, Examiner suggests that Mitchell further discloses means for automatically selecting, based on biometric information, an account from plural accounts ([0017]-[0018] and [0049]).

However, the selection of accounts disclosed in Mitchell apparently involves manual user manipulation of "controls" to select an account via an EFTPOS [0049], wherein the account is associated with a biological identifier. This in no way teaches, discloses, or suggests automatic selection of an account from among plural accounts based on biometric data. Instead, the biometric data in Mitchell is employed to authenticate a user for access to an account or to process a transaction, such as by determining approval of a transaction (e.g., bottom portion of [0034]). Biometric data is not used to perform the account selection as claimed.

While Mitchell appears to disclose using different fingerprints to access (not select) different accounts (last portion of [0008]), an account associated with a given fingerprint is not automatically selected. Instead, Mitchell requires the user to manipulate controls to select accounts, as discussed in the last sentence of on [0050] of Mitchell and in [0049], second sentence.

Hence, nowhere does Mitchell suggest that an account is selected based on which type of biometric information is submitted. For example, unlike Mitchell, an embodiment of the invention as claimed in Claim 3 might enable a user to automatically *select* an American Express card number for retrieval to the charging terminal when providing biometric information via his right iris and to automatically *select* a particular Visa^(R) card number for retrieval when providing biometric information via his left eye, or to automatically select a highest priority account from among plural accounts when providing certain biometric information. Note that the only information returned to the charging terminal of Mitchell is a transaction confirmation or indication of a declined transaction ([0035]).

Regarding Claim 4, Examiner suggests that Mitchell discloses second means for enabling a user to control which account number is selected by the first means as recited in Claim 4 ([0049]). Examiner suggests that the controls referred to by Mitchell in [0049] are sufficient to disclose the second means recited in Claim 4.

However, Mitchell instead discloses use of POS controls to enable a user to select one or more accounts associated with a biological identifier that the user provides ([0049]). Hence, in this case, Mitchell is employing the biological identifier to authenticate a user to use a particular account, which may be used instead of a signature. Mitchell does not even disclose *selection* of accounts via biometric data, rather Mitchell discloses enabling *access* to accounts or charging an account via use of biometric data. Certainly, Mitchell in no way teaches, discloses, or suggests enabling a user to readily configure or control how accounts are selected based on certain biometric input.

Note that the present Application teaches use of a user-accessible remote database 32 (Fig. 1 of the present Application), whcrcby account selection rules may be configured by a user, such as via a PC 42. Note that Mitchell does not disclose the remote database 32, which would enable a user to configure account-selection rules. Instead, the clearing house of Mitchell maintains biometric data, and biometric data must be transmitted to the clearing house or bank to proceed with a transaction [0064], [0023], [0034]. See also [0044], where a customer applies to MasterCard to use their fingerprint. Consequently, the user cannot readily change his registered biometric information or parameters

associated therewith. Any such change would be implemented by the bank or credit card company after the user tediously contacts the clearing house and each bank to re-register the biometric information.

As an addition example, Mitchell does not anticipate enabling a user to configure the system to automatically select one card in response to biometric information pertaining to the left eye and another card in response to biometric information pertaining to the right eye, and to readily change the configuration as desired. In addition, Mitchell does not disclose enabling a user to, for example, automatically select an account via a combination of a thumb scan and an iris scan (e.g., p. 13, ln. 24-27 of the present Application). In addition, Mitchell does not anticipate enabling a user to configure the system to allocate, for example, charges above a certain dollar amount to a card with a higher limit (p. 12, ln. 16-19 of the present Application). Hence, the invention as claimed in Claim 4 is not anticipated by and is not obvious in view of Mitchell.

Regarding Claim 5, Examiner suggests that Mitchell further discloses arrow keys that anticipate the third means for enabling a user to prioritize plural accounts, an available account with the highest priority being automatically selected by the first means [0050]. Examiner further suggests that the merchant could prioritize accounts according to some scheme [0050]-[0051].

Instead, Mitchell discusses use of a display to enable a customer to choose between commonly used credit card or charge card companies, e.g., MasterCard, Visa, etc. approved by a particular merchant [0050]. This in no way teaches, discloses, or suggests prioritization of accounts. Instead, Mitchell teaches selection of a credit card or a charge card company. Certainly, Mitchell does not disclose prioritizing accounts, where an available account is automatically selected for retrieval to a charging terminal as claimed. Merely providing a list of merchant-approved credit card or charge card companies as taught in Mitchell is entirely different than enabling a user to prioritize or sort accounts so that an available account with the highest priority is automatically selected for retrieval to a charging terminal. Any suggestion that the credit card or charge card companies or associated accounts may somehow be prioritized by a user or merchant in Mitchell would require hindsight, as such suggestion does not appear in Mitchell.

Furthermore, any such prioritization would not result in automatic selection by a mechanism (first means) that automatically retrieves the corresponding account number to a charging terminal.

Recall that Mitchell does not teach use of biometric information to select an account, but rather to access an account. Furthermore, any selection of an account taught in Mitchell would not be automatic as claimed, but would require manipulation of controls, as taught in [0049] of Mitchell. Consequently, Mitchell does not anticipate the invention as claimed in Claim 5.

Regarding Claim 6, Examiner suggests that Mitchell further discloses software (Fig. 3 of Mitchell) that enables a user to trigger automatic selection of an account based on which type of biometric information or combination of biometric information that the user provides [0049].

Applicant finds no mention in Mitchell of software that enables a user to trigger automatic selection of an account based on the type of biometric information provided. The paragraph ([0049]) referred to by Examiner discloses use of “controls” to enable a user to select an account associated with a biological identifier. Use of such controls would not constitute automatic selection of an account, as the selection must be performed by the user via user input. Hence, Mitchell does not teach, disclose, or suggest the invention as claimed in Claim 6.

Nowhere does Mitchell suggest that a reader or other device could enable, for example, a user to trigger selection (let alone automatic selection) of an account based on whether the user provides biometric information pertaining to facial scan, an iris scan of one eye, a combination of a thumb print and a voice scan, etc., as enabled by an embodiment according to Claim 6.

The features recited in various claims, such as Claim 6, are particularly beneficial, enabling users to associate different body parts or other biometric information or combinations thereof with different account numbers. This may eventually obviate the need for a user to carry any card, including a drivers license, as the biometric information may enable retrieval of photographs, license numbers, and so on, to an appropriate terminal as needed for a particular application. Such significant benefits suggest that the

invention is not obvious, especially considering that the invention has not been implemented or disclosed in the art of record.

Regarding Claim 7, Examiner suggests that Mitchell further discloses fourth means for providing transaction information to the first means as claimed in Claim 7.

However, since Mitchell does not disclose the first means as indicated above, Mitchell necessarily does not disclose sending transaction information thereto.

Regarding Claim 8, Examiner suggests that Mitchell further discloses fifth means ([0053]-[0056]) for enabling a user to specify selection rules or selection criteria based on transaction information that dictate which account is selected by the first means.

Instead, Mitchell merely discloses associating different biological identifiers with different accounts. This in no way teaches, discloses, or suggests specifying selection rules based on transaction information. Instead, Mitchell at most teaches association of different biological identifiers with different accounts so that different accounts can be manually selected via controls as taught in [0049]. For example, a user may submit one finger to a fingerprint reader and then select that corresponding account associated with the biological identifier. Use of additional fingers for different accounts would in no way suggest or teach a mechanism for enabling a user to specify selection rules based on transaction information that dictate which account is automatically retrieved to a charging terminal. Recall that Mitchell does not even disclose retrieval of account information to the charging terminal. Clearly, Mitchell neither teaches, discloses, nor suggests use of selection rules that dictate or control *automatic* selection of an account, let alone selection of an account based on transaction information or biometric information.

Unlike Mitchell, an embodiment according to Claim 8 might enable a user to automatically charge dinners to a Discover^(R) card; to charge airfares to an American Express^(R) card; and to charge gasoline to a MasterCard^(R). Alternatively, a user may specify that transactions above a certain dollar amount be charged to one account, and transactions below a certain dollar amount be charged to another account (as discussed, for example, on page 12, lines 16-25 of the present Application). Such functionality may yield significant previously unanticipated results in enabling users to organize, categorize,

charge, and account for various expenses. Such significant results suggest that the invention is not obvious, as discussed more fully below.

Regarding Claim 9, Examiner suggests that Mitchell further discloses sixth means for limiting selection of account numbers as claimed in Claim 9. Examiner suggests that the POS terminal of Mitchell will have a card reader to read the magnetic strip on a credit or debit card, and that this information is linked to a keypad on an EFTPOS remote terminal that enables the customer to enter a PIN if required. Examiner further suggests that in the case of a credit card transaction, the user may push the button marked "credit" so that the information from the card and the customer's PIN if required is transmitted to a clearing house.

However, even if Mitchell discloses what the Examiner suggests, use of a card reader to relay credit card information and PIN to a clearing house in no way teaches, discloses, or suggests a mechanism for employing transaction type information to limit automatic selection of account numbers to only those account numbers that are compatible with the transaction type. For example, a user may select or provide to the card reader of Mitchell any account number, even a driver's license number. Although a transaction will unlikely be completed if the wrong information is provided, the card reader of Mitchell does not limit the user from entering or selecting such account numbers or information, unlike the invention as claimed. Consequently, if a user provides an inappropriate card or account number in the system of Mitchell, this may further result in delayed checkout lines, as the clearing house must return a declined transaction signal. The user may then try different cards until one works, which may be time consuming.

Note that in the present Application, the selection of account numbers may be performed, for example, by the remote database 32 of Fig. 1. Mitchell does not disclose any module that is similar to the remote database 32 of Fig. 1.

Note that Mitchell suggests that a customer must choose, via the POS, from among commonly used merchant-approved credit card or charge card companies. Generally, in Mitchell, any selection of account numbers is user-controlled ([0049]), while access is enabled via a biometric identifier. Nowhere does Mitchell disclose a

mechanism for selectively limiting selection of account numbers as recited in Claim 9. Any mechanism for selecting account numbers would be the user himself/herself, which should not be considered a mechanism, and account selection would not be considered automatic.

Hence, Mitchell does not disclose automatic selection or retrieval of account numbers and certainly does not disclose use of transaction type information to limit automatic selection of account numbers. Rather, Mitchell implies that a user must use controls to select which account to use [0049]. Accordingly, Mitchell does not anticipate the invention as claimed in Claim 9.

Regarding Claim 10. Examiner suggests that Mitchell further discloses a database [0018] that is remotely accessible to a user and that the database includes means for authenticating the user before allowing the user to alter selection rules associated with user accounts ([0019]-[0021]).

However, the database discussed in Mitchell is a database at the clearing house, where the biometric identifier and transaction is processed ([0023], [0034], [0052] first sentence, etc.). The database at the clearing house clearly cannot be readily edited or configured by a user. Instead, the user must, for example, apply to MasterCard to use their fingerprint ([0055] at p. 4, col. 2). Alternatively, the user applies to the bank ([0024], at p. 2, col. 2). Hence, the user cannot readily edit their biometric information via a particular mechanism of Mitchell, and certainly cannot alter account selection rules via a database of Mitchell.

The requirement that the user apply at each bank or credit card company is particularly problematic, as discussed more fully below. For example, if the user has multiple cards, the user must perform a tedious process to change biometric information at each bank or credit card company. Furthermore, Mitchell would result in the undesirable proliferation of credit card information among banks, credit card companies, and clearing houses. Note that the clearing house database discussed in Mitchell likely obtains biometric data from the credit card companies, since the biometric data must be processed by the clearing house ([0014], [0023] at p. 2). Hence, the user would not have direct access to the clearing house database to alter account-selection rules. User access

to clearing house databases is unlikely, since clearing houses are well known to closely guard access to their databases. Hence, Mitchell does not anticipate the invention as claimed in Claim 10.

Regarding Claim 11, Examiner suggests that Mitchell further discloses seventh means (clearing house: [0051]-[0052]) for automatically providing transaction information to a charging terminal.

However, note that Mitchell does not disclose automatic retrieval of an account number to a charging terminal as recited in Claim 1, and consequently, does not teach the invention of Claim 11. Note that Mitchell does not disclose, for example, automatic retrieval of transaction amount, transaction type, and so on, to a charging terminal (p. 12, ln. 6-7 of the present Application), but instead teaches that an approval or declined indication is provided to the charging terminal [0034].

Regarding Claim 15, Examiner suggests that Mitchell discloses a payment system (Fig. 1) as recited, including first means for measuring one or more biological characteristics (fingerprint reader); second means for automatically selecting an account (controls along with arrow keys); and third means for implementing a funds transfer ([0052]).

Note, however, that use of controls and arrow keys to select an account (e.g., [0049]) would not constitute automatic selection performed by a mechanism or means as claimed in Claim 15. Instead, the controls and arrow keys require manual user input. Even in the embodiment of Mitchell that employs the "fingerprint credit card," account selection is not automatic. The user must still inform the vendor, i.e., select, whether the user will use a credit, debit, or fingerprint card, etc. ([0050], last portion). Accordingly, Mitchell does not teach, disclose, or suggest a mechanism for automatically selecting accounts as claimed in Claim 15. Hence, Mitchell does not anticipate the invention of Claim 15.

Since Claim 15 as amended is not taught, disclosed, or suggested by Mitchell, the corresponding dependent Claims 16-24 are also necessarily not taught, disclosed, or suggested by Mitchell. Nevertheless, the following discussion of the rejections pertaining to each claim further exemplifies how the claims distinguish over the art of record.

Regarding Claim 16, Examiner suggests that Mitchell further discloses means for providing a first signal (good scan) based on one or more biological characteristics, said first signal acting as an authorization signal, an authentication, and an account-selection signal, the second means providing the transaction signal based on the first signal (acceptance).

However, the biological identifier of Mitchell is not used to select an account, but instead is used as an authentication signal to access an account. Note that in Mitchell, account selection is apparently performed by a user who employs controls to select an account, as discussed in [0049] of Mitchell, instead of via the biological identifier. Mitchell does not specifically teach or suggest use of a biometric to choose specifically between user accounts.

Note that Mitchell does not apparently disclose the second means for *automatically* selecting an account. Consequently, Mitchell necessarily does not disclose use of the second means to provide a transaction signal based on the first signal (good scan) as claimed in Claim 16. In rejecting the parent Claim 15, Examiner suggests that the second means of Claim 15 corresponds to controls and arrow keys of Mitchell. However, clearly, the controls and arrow keys of Mitchell, which must be controlled by a user, cannot automatically provide (by themselves) a transaction signal based on the first signal (good scan). Mitchell would require manual user participation, and Mitchell would require the user to be part of the second means. However, a human should not generally be used as a "means" to reject a claim, as forcefully stated, for example, in *In re Prater*, 415 F.2d 1393, 1398 (CCPA 1969). See also *Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc. et al*, No. 05-1069 (Fed. Cir. 2005), where the Court determined that "...arguments that the structure corresponding to the 'means for dispensing' can entail human (or 'merchant') participation or a human being manually operating an apparatus, are equally misplaced." (Emphasis added.) Hence, Mitchell does not anticipate the invention as claimed in Claim 15 and certainly not Claim 16 and should not be used for rejection thereof.

Regarding Claim 17, Examiner suggests that Mitchell further discloses that the second means includes a database ([0017]-[0018]) for selectively outputting account information contained in the transaction signal based on the first signal.

However, recall that in rejecting the parent Claim 15, Examiner suggests that the controls and arrow keys of Mitchell represent the second means. Control and arrow keys cannot themselves output account information and cannot themselves include a database. Consequently, the second means of Mitchell would not anticipate Claim 17.

Nevertheless, the database referred to in [0017]-[0018] of Mitchell does not output account information contained in a transaction signal as claimed in Claim 17. Any account information, which is used internally in the clearing house of Mitchell, would be information stored in the database and not contained in a transaction signal. Mitchell does not teach retrieving account information in a transaction signal and then outputting the account information as claimed.

Clearly, the approved or declined indication ([0034], last sentence thereof) provided by the clearing house is not account information, such as an account number, an account balance, and so on; and is not apparently output by a database. Instead, the approved or declined indication provided by the clearing house pertains to whether a given transaction is authorized or not. Recall that the database of Mitchell is integrated with the clearing house so that the clearing house can store information, as indicated in [0023] of Mitchell.

Hence, nowhere does Mitchell teach mechanisms for using biometric information as a database key to enable a database to authenticate a user and to select an account *and* to provide account information, such as an account number and PIN, in response to the account selection and user authentication. Instead, account selection is performed via user input [0049], and an approved or declined indication, not account information, is returned from the clearing house in Mitchell.

Regarding Claim 18, Examiner suggests that Mitchell further discloses a database that includes a user-configurable account list that enables a user to control which account is automatically selected by the second means in response to the first signal (good scan; [0024]-[0025]).

However, as discussed above, the account selection in Mitchell is apparently not automatic [0049]. Note that since Mitchell does not disclose *automatic* account selection by a second means, Mitchell necessarily does not disclose enabling a user to configure automatic account selection behavior as claimed in Claim 18.

While Mitchell apparently stores information in a machine-readable form ([0023]), Mitchell does not teach, disclose, or suggest a mechanism to allow the user to readily configure the information. At most, Mitchell teaches that a user can select accounts ([0049]) but not modify the database.

As discussed above, a bank or clearing house is unlikely to allow a user to modify or configure the bank's databases. Instead, a user would have to apply (e.g., [0044] last portion), and then the bank or MasterCard would then edit their own databases accordingly, if they accepted the user. This in no way teaches, discloses, or suggests, user modification of the databases. Even if Mitchell did disclose user modification of the clearing house databases, which could be a security concern, the database discussed in Mitchell lacks any mechanism to enable a user to change which account is automatically accessed in response to a given "good scan." Accounts are not even automatically accessed. Hence, Mitchell does not anticipate or suggest Claim 18.

Regarding Claim 19. Examiner further suggests that Mitchell includes means for identifying a user (biometric reader and card/check reader; [0033]) before enabling the user to access or configure information that is stored via the database.

However, the computer discussed in [0033] of Mitchell is used to make Internet-based purchases ([0064]-[0083]) and not to store or configure information in the database as claimed. Nowhere does Mitchell teach, disclose, or suggest that the computer is equipped to enable a user to configure or access information stored in the database, which in Mitchell is apparently maintained at the clearing house, banks, or credit card companies in communication with the clearing house.

The biometric reader and card/check reader of Mitchell is apparently used to authenticate a user for a financial transaction and to implement the transaction. Mitchell in no way suggests that the biometric reader and card/check reader are used to identify a user before allowing the user to configure or access a database. In Mitchell, the user does

not have access to the database. Instead, the database is used internally by the clearing house or by the clearing house in communication with one or more banks or credit card companies. See Fig. 4 of Mitchell, for example, where the user input is limited to a transaction entry 100, which may involve submitting to a fingerprint scan via a fingerprint reader (Fig. 1 of Mitchell). Submitting a transaction entry is entirely different than modifying, accessing, or configuring a database. Hence, Claim 19 is not anticipated by and is not obvious in view of Mitchell.

Regarding Claim 20, Examiner suggests that Mitchell further discloses a means for enabling a user to predetermine account selection rules for accounts listed in the database ([0055]).

However, Mitchell does not teach use of account selection rules for accounts listed in a database and certainly does not teach user-modification of account selection rules. Instead, account selection is performed manually by the user via relatively tedious interaction with a POS ([0049]-[0050]).

Modification of any account selection rules, which are not taught in Mitchell, would require user access to a clearing house or bank database and would require the user to have database-modification privileges. This is undesirable and unlikely. Any modification to a clearing house or bank database would be performed by the clearing house or bank at the discretion of the clearing house or bank, and not by the user, as made clear in [0055] of Mitchell. Hence, Claim 20 is not anticipated by and is not obvious in view of Mitchell.

Regarding Claim 21, Examiner suggests that Mitchell further discloses a terminal that is positioned remotely from a POS that enables a user to predetermine account selection rules (EFTPOS remote in Fig. 1 of Mitchell).

However, the EFTPOS remote of Mitchell is for entering a transaction (100 of Fig. 4), which would occur at a POS, unlike the invention as claimed in Claim 21. One should not be confused by the term "remote terminal" as implying that the terminal is located separately from the POS. Instead, Mitchell confirms that the EFTPOS remote may be located at a merchant store, i.e., at a POS ([0085], first sentence).

Furthermore, as the name implies, the EFTPOS is an Electronic Funds Transfer (EFT) Point-Of-Sale (POS) terminal, and consequently, is positioned at a POS. The EFTPOS remote terminal is called "remote" likely because it is coupled to the card reader and not incorporated therein (as shown in Fig. 1 of Mitchell). The assembly of devices of Fig. 1, including the EFTPOS remote, are apparently co-located at a POS and Mitchell does not suggest otherwise.

Nevertheless, even if the EFTPOS remote were positioned remotely from a POS, Mitchell still does not teach, disclose, or suggest use of the EFTPOS to modify a database or to enable a user to configure or predetermine account selection rules as claimed. Selecting an account to charge via an EFTPOS terminal is entirely different than predetermining account selection rules. Hence, Mitchell does not teach, disclose or suggest a terminal positioned remotely from a point-of sale that enables a user to predetermine account selection rules as claimed in Claim 21. Accordingly, Claim 21 is not anticipated by and is not obvious in view of Mitchell.

Certain embodiments of the present invention may enable a user to configure the system at home or via other remote terminal away from the POS. This may result in potentially significant benefits, especially in terms of reduced checkout lines at merchant outlets, such as stores, restaurants, and so on. The system of Mitchell apparently requires the navigation of potentially complicated or intimidating user interfaces at a POS, which may be particularly problematic, as discussed more fully below.

Regarding Claim 22, Examiner suggests that Mitchell further discloses means for employing the first signal (good scan) to authenticate (credit database matching process and resulting signal) the user before providing the transaction signal to the third means ([0052], clearing house).

However, the mechanism for implementing a funds transfer in Mitchell is apparently the clearing house ([0052]; [0023], last portion). Consequently, the "good scan" of Mitchell is not employed to authenticate the user *before* providing the transaction signal to the clearing house. In the system of Mitchell, processing of the biometric data (authentication) would have to occur at the POS to teach authenticating a user before a transaction signal is sent to the clearing house. Instead, processing of

biometric data clearly occurs at the clearing house in Mitchell (e.g., [0014], [0023]). Hence, Claim 22 is neither anticipated by nor is obvious in view of Mitchell.

Regarding Claim 23, Examiner suggests that Mitchell further discloses means for storing information pertaining to one or more biological characteristics of a user when the means for employing fails to authenticate a user [0051].

However, checking whether a scan of a biological identifier is a good scan or a bad scan, as discussed in [0051] of Mitchell, is entirely different than storing biological characteristics when a mechanism fails to authenticate a user. Furthermore, determining if a scan is good or bad is not equivalent to authenticating a user, but instead determines if the scan is sufficiently clear [0051]. Hence, Mitchell does not teach, disclose, or suggest a mechanism for storing biometric data associated with a failed authentication attempt.

If Mitchell had anticipated such, then Mitchell surely would have suggested that storing of information pertaining to failed authentication attempts could be used to thwart fraud as discussed in the present Application. See the fraud-alert system, as discussed, for example, on p. 8, ln. 15-25 of the Application. Such significant results are not taught or suggested by any mechanism or combination of mechanisms in Mitchell.

Hence, Mitchell does not state or suggest that biological characteristics are stored *when* authentication fails as recited in Claim 23, and Claim 23 is neither anticipated by nor is obvious in view of Mitchell.

Regarding Claim 24, Examiner suggests that Mitchell discloses third means that includes a credit card, charge card, and/or Automated Teller Machine (ATM) charging module, and wherein the transaction signal includes a selected credit card, charge card, or ATM card number associated with said user and any relevant pins or dates ([0052]).

However, the clearing house as discussed in [0052] of Mitchell does not include a credit card, charge card, and an ATM charging module and, consequently, does not anticipate Claim 24.

Note that the charging modules of Mitchell (Fig. 1 of Mitchell) do not implement a funds transfer in response to a transaction signal provided by a mechanism (second means) for automatically selecting an account. For example, Mitchell does not teach, disclose, or suggest a database, such as the database 32 of Fig. 1 of the present

Application, that provides a card number (transaction signal) to a charging module. Hence, Claim 24 is neither anticipated by nor is obvious in view of Mitchell.

In summary, nowhere does Mitchell teach, disclose, or suggest use of biometric information to automatically select or retrieve account information from a database to a charging terminal. In addition, Mitchell does not teach, disclose, or suggest use of biometric information as a database key (such as recited as the first means limitation of Claim 1 and as discussed more fully on page 10, lines 12-15 of the present Application) to retrieve payment information, such as a preferred credit card number, to a credit-card charging terminal or other charging terminal. Instead, Mitchell suggests use of biometric information in place of credit card data or in combination therewith. The account information is not automatically delivered to a charging terminal based on biometric information.

Embodiments of Mitchell generally require a user to manually select an account for charging, such as via a controls [0049] and a user interface [0050], which requires, for example a user to press an "OK" button. Mitchell generally neither discusses automatic *selection* of an account based on predetermined rules nor discusses automatic retrieval of the selected account information to a conventional terminal.

Rejections Under 35 U.S.C. 103(a)

In rejecting Claims 12-14 under 35 U.S.C. 103(a) Examiner suggests that the combination of Kipp (U.S. Patent No. 5,239,167) and Mitchell disclose the invention as claimed in Claims 12-14.

Kipp purportedly discloses a system for unassisted checkout in applications involving wireless interrogation of randomly disposed articles in a container. However, Kipp does not disclose or suggest disabling anti-theft alarm-triggering features on a tag (Claim 14). For example, the distress signal emitted by a tag of Kipp (as discussed in column 4, lines 39-48 of Kipp) is not an anti-theft signal, but instead, the distress signal alerts an employee to a product that may, for example, require manual pricing. Furthermore, the distress signal is only triggered after the tag is activated at the checkout.

A thief is unlikely to pass a checkout line to activate a tag before exiting a merchant outlet.

The combination of Kipp and Mitchell would show at most a system for using a biological identifier as a credit card number via a terminal that requires navigation of a user interface ([0049]-[0050]), to pay a total determined by Kipp. Such a combination would not teach disclose or suggest the invention as claimed and would lack various benefits, including anti-theft provisions, *automatic checkout*, and so on.

The alarm triggering features disclosed in the present application are adapted to prevent theft of merchandise (Claim 14), which is unlike Kipp, which uses an alarm to notify a user that a product may, for example, require manual pricing (col. 4, lines 39-48 of Kipp). Accordingly, the invention is not obvious in view of the combination of Kipp and Mitchell. Nevertheless, the references should not be combined to reject the Claims, as discussed more fully below.

The References Cited Address Different Problems

Examiner relies upon Mitchell and Kipp to reject the claims. However, these references take different approaches to solve mutually different problems that are different from the problem addressed by the present invention. Hence, they should not be used alone or in combination to reject the invention as claimed (*In re Wright*, 6 USPQ 2d 1959 (1988)).

In particular, Kipp purportedly discloses a checkout system for wirelessly interrogating randomly disposed articles in a container, while Mitchell discloses a system for authenticating a financial transaction. Accordingly, the references address different problems, and they should not be combined to reject the present invention.

Furthermore the problems addressed by the cited references are different than addressing checkout lines and waits associated with use of cards or complex user interfaces, as addressed by certain embodiments of the present invention.

Unsuggested Combination Of References

The references cited do not suggest, expressly or implied, that they be combined to teach the invention as claimed. The references take mutually exclusive paths and reach different solutions to different problems. Hence, they should not be combined as maintained by *In re Wright*, 6 USPQ 2d 1959 (1988). Furthermore, strained interpretations were relied upon to combine the references to reject the claims.

In the above-identified Office Action, the suggestion to combine features from the various references to show the present invention has not come from the prior art references themselves. Prior art references themselves should suggest that they be combined for rejection of claims under 35 U.S.C. 103, which was forcefully stated, for example, in *In re Sernaker*, 217 U.S.P.Q. 1, 6 (CAFC 1983):

"[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

The system of Kipp is a stand alone system that is individually complete. It is unclear how Kipp should be modified for use with the system of Mitchell. Such a combination would likely require special hardware and/or software (to interface the systems) that is not taught or suggested in the art. Accordingly, the combination of Mitchell and Kipp would be unobvious.

Furthermore, if it were obvious to couple a system for wirelessly interrogating product tags with a system that enables automated payment via biometric information, then surely it would have been done due to the significant advantages afforded thereby as discussed more fully below.

While use of Kipp may expedite checkout in certain applications, one of the most time consuming tasks, i.e., paying for the merchandise, is not addressed by Kipp, and Mitchell requires potentially slow and cumbersome interaction with a relatively

complicated user interface. Accordingly, combination of Kipp with the teachings of the invention as claimed is not obvious. Otherwise, such a combination would surely have been made due to the virtual elimination of checkout lines that would result.

Such a result represents a synergistic benefit, since any reduction in or elimination of an individual user's time spent paying for merchandise translates into time savings for all customers in line. The elimination of the line results in additional significant, potentially unexpected or previously unanticipated results, namely, more customers will likely be attracted to merchants that do not have lines, thereby increasing merchant business. Such synergistic benefits suggest that the invention as claimed is not obvious.

Furthermore, the invention of Mitchell would theoretically require modifying a preexisting charging terminal or card reader (Fig. 1 of Mitchell) to be able to send biometric data to a clearing house. This is unlike embodiments of the present invention, which are adapted for use with preexisting charging terminals, and hence, may more readily work with existing infrastructure.

Unexpected Results And Significant Advantages

In *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967) a significant improvement over the related art was held sufficient to rebut *prima facie* obviousness based on close structural similarity. Similarly, in *In re Weymouth*, 499 F.2d 1273, 182 USPQ 290, 293 (CCPA 1974), the court held that unexpected results for a claimed range as compared with the range disclosed in the prior art had been shown by a demonstration of "a marked improvement, over the results achieved under other ratios, as to be classified as a difference in kind, rather than one of degree." The present invention provides a marked improvement over the references cited or combinations thereof, as discussed more fully below.

Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art (see *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP 716.02(d) - 716.02(e)). Hence,

Applicants' following comparisons of the present invention with the art of record should be sufficient to establish unexpected properties.

Mitchell requires clearing house, bank, and credit card company participation

Note that Mitchell does not teach retrieving a credit card number to a charging terminal, but instead requires modifications to the clearing house, i.e., requires a clearing house to accept the invention, since the clearing house must process or handle information, such as biometric identifiers, in accordance with the teachings of Mitchell (e.g., [0052], [0014], [0034], [0064]). Requiring cooperation of the clearing house, which has the power to decline implementation of the invention if it desires, may severely inhibit widespread use of the invention. Furthermore, even if one clearing house accepts Mitchell, other clearing houses may not, which may result in Mitchell only being sporadically usable when a particular merchant employs a particular clearing house or combination of clearing houses that accommodate Mitchell. This is extremely disadvantageous when compared to the invention as claimed and various embodiments disclosed in the Application.

In addition, Mitchell teaches that a user must supply biometric information to the bank or credit card company. Note that each user account in Mitchell is associated with a bank with which the user has previously registered biometric data, as indicated in the portion of [0024] beginning on p. 2, col. 2 of Mitchell. Registering such data with multiple entities would be particularly problematic if the user has multiple cards. For example, persons with multiple credit cards must register their biometric information multiple times. In addition, such multiple registrations would result in replication and storage of sensitive biometric information at different credit card companies and banks. This is particularly undesirable and increases the risk for fraud, as the sensitive biometric information is exposed to more handlers ([0024], p. 2, col. 2).

In addition, use of the biometric information as taught in Mitchell requires acceptance of Mitchell by the bank providing, for example, the MasterCard. See, for example, [0055], p. 4, col. 2 of Mitchell, where a customer applies to MasterCard to use

their fingerprint. Hence, if a bank, credit card company, or clearing house decides not to participate in Mitchell, the Mitchell cannot be implemented for a particular card. Consequently, Mitchell gives banks, credit card companies, clearing houses, and so on, the ability to hold Mitchell's invention hostage, i.e., to effectively prevent its implementation and widespread use if they so choose.

Furthermore, unlike the invention as claimed and disclosed in the Application, with Mitchell, the user cannot readily change his registered biometric information without tediously contacting each bank to re-register the biometric information and then have the bank update the data. Furthermore, note that the biometric information, encryption, and encoding methods may be different at different banks. Consequently, competing biometric-processing standards could slow successful implementation of the system, unlike the invention as claimed, which does not depend on the acceptance of the system by multiple entities or parties. This is a significant result to be classified as a difference in kind rather than of degree. Hence, the invention is not obvious in view of Mitchell.

Unlike the invention as claimed, Mitchell apparently requires use of a biological identifier to determine approval of a transaction ([0034], p. 3, bottom section). This is unlike how biometric information is employed in the present Application, where the biometric information is not used to determine approval of a transaction, but instead is employed to retrieve a credit card number or other relevant numbers to a charging terminal. Accordingly, the present invention is more readily implementable as it does not require additional functionality at the clearing house; does not require permission of a clearing house; does not require that the clearing house have access to biometric data; and does not require user registration at each bank issuing each credit card or bank card. These benefits represent significant results over benefits afforded by Mitchell.

Mitchell lacks configurability and key functionality

The system of Mitchell is not configurable by the user as taught or claimed in the present application and lacks fraud-reporting features, such as the fraud alert system 52 of Fig. 1.

Mitchell further lacks ability to use a combination of biometrics to charge a card, which makes Mitchell more susceptible to fraud. For example, a user that steals a fingerprint biological identifier would more readily be able to make a fraudulent charge with a system that can only use one biological identifier at a time to charge a particular card. Furthermore, note Mitchell does not teach use of a combination of biometrics to facilitate selecting a card that has been prioritized based on certain criteria as taught in the present Application.

Note that Mitchell does not use a database that is separate from the clearing house database. Selection of accounts is performed by a user at a POS ([0048]-[0050]), and Mitchell does not teach, disclose, or suggest user-configuration of account selection rules elsewhere. No database of Mitchell enables user-configuration of account selection rules for multiple credit cards or charge cards.

Mitchell is significantly more susceptible to fraud

The process outlined by Mitchell ([0066]-[0083]) to make Internet transactions via fingerprints, involves sending an image of the fingerprint to a merchant for charging. This process is undesirably prone to fraud, as interception of images via the Internet is commonplace. Consequently, interception of an image of a fingerprint that is provided to each website from which the user wishes to make a purchase, results in the proliferation of sensitive biometric data among various merchant websites. This increases exposure to potential fraud.

This is unlike the invention as claimed, which may receive biometric information into a single remote database (database 32 of Fig. 1 of the present Application), which may enable selective dispensing of credit card information in response thereto. If credit card information gets stolen, a new card number can be issued. Unfortunately, new fingerprints are harder to "reissue." It is likely much safer to proliferate credit card numbers among Internet merchants than to proliferate images of fingerprints. The invention as claimed clearly minimizes any undesirable proliferation of biometric data.

Mitchell requires undesirable user interaction at the POS

Mitchell requires additional user input at the POS, which may result in checkout lines ([0049]-[0050]). For example, unlike the invention as claimed, the merchant in Mitchell asks the customer whether they will be using debit or credit ([0050] see second sentence from the top of page 4). The user also nominates an account associated with a particular fingerprint [0049].

Hence, Mitchell provides virtually no advantage in terms of reduced checkout lines or time spent in line, since the user must provide input to the POS – p. 4, ¶ 50. This is unlike the invention as claimed, where account selection at the POS is automatic.

The system of Mitchell employs the biometric information primarily as an authenticator to enable charging of certain accounts and not to select certain accounts as in the invention as claimed. While Mitchell anticipates using different prints to *access* (not select) different accounts ([0008], p. 1, last portion of the paragraph), the account associated with a given fingerprint is not automatically selected. For example, the user must also press the “OK” button as indicated in [0050] of Mitchell, represents additional user input. User interfaces required to implement Mitchell may be undesirably complicated for users to navigate at the POS, which defeats any time savings at the POS and may result in lengthy lines. This is unlike certain embodiments disclosed in the present Application, which do not require complicated interface navigation at the POS. Instead, the user may perform any configuration at home, away from the POS, such as via the user terminal 42 of Fig. 1 of the present Application.

Hence, the invention as claimed provides several potentially significant benefits over the art of record. For example, users no longer need to repeatedly interact with a potentially complex user interface when checking out. This expedites checkout lines; obviates the need for users to carry a credit card, ATM card, etc., which are subject to loss or theft; accounts of one’s choosing may be selected with different biometric information, thereby obviating the need to carry plural cards to have plural account-charging options, and so on.

The invention as claimed is versatile and highly advantageous

For example, unlike Mitchell, an embodiment, such as according to Claim 8, might enable a user to *automatically* charge dinners to one type of card and to charge airfares to another type of card. Alternatively, a user may specify that transactions above a certain dollar amount be charged to one account, and transactions below a certain dollar amount be charged to another account (as discussed, for example, on page 12, lines 16-25 of the present Application). Such functionality may yield additional significant previously unanticipated results in enabling users to organize, categorize, charge, and account for various expenses.

As another example, unlike Mitchell, embodiments of the invention as claimed, such as in Claim 23, may facilitate identifying fraudulent charge attempts and by maintaining suspect biometric information that may be employed by authorities to facilitate pursuing fraud perpetrators.

Unlike Kipp, the invention as claimed, such as in claim 14, may be employed to thwart product theft, facilitate rapid checkout, and simultaneously facilitate totaling of product prices. Hence, in light of various significant advantages afforded by embodiments of the invention as claimed, the invention is not obvious in view of the art of record either alone or in combination.

The invention as claimed may employ biometric information to both authenticate a user and to select a preferred account in accordance with predetermined rules. In certain embodiments, these rules are configurable by a user and do not require the user to be at the point of sale to perform the configuration. Rather, the user can perform this configuration via the Internet once (or as desired). Hence, a user may pay for items using their iris, for example, instead of a credit card number. For example, a user may choose to associate one credit card with the left iris and another credit card with the right iris (see Claim 6). Unlike Mitchell, this association may be done, for example, via an online website before a user ventures out to go shopping. Once this initial association/configuration is performed, a user may make purchases at merchants equipped with an embodiment of the present invention without requiring interaction with

a cumbersome user interface with various pull-down menus that must be navigated at the POS. Use of the menus required by Mitchell at the point of sale may require additional time, which contributes to lines and additional wasted time. Such wasted time is saved via use of embodiments of the present invention.

Embodiments of the present invention may employ a synergistic use of biometric data and payment information to reduce lines at merchant outlets and to facilitate purchasing in general. Mitchell merely discloses use of biometric data as a way to authenticate a user to enable a user to charge an account; not as a way to select a particular account or account number for charging via the system. Using biometric information to allow access to account information is entirely different than using the biometric information to select particular account information and then have this account information automatically delivered to a pre-existing charging terminal, such as a conventional credit card payment terminal.

If Mitchell had indeed anticipated that biometric information could be used to obviate the need for a complicated POS interface, then surely Mitchell would have disclosed it here, considering the significant benefits afforded thereby. Additional exemplary benefits include; the entering of PINs, signing of receipts, clicking login or authorize buttons, and so on, are no longer required. A user may configure the system of the present invention once, and additional configuration may not be required when making purchases.

Furthermore, if Mitchell had anticipated the invention as claimed, then surely Mitchell would have noticed that use of the magnetic stripe would be redundant if biometric information could already be employed to both authenticate and select an account for use. For example, see reader of Fig. 1.

Unlike the invention as claimed, Mitchell requires user interaction with a POS terminal, which requires the user to interact with screens and likely wait in line at a checkout station. This is unlike the present invention, which may virtually eliminate lines and requires little or no interaction with a terminal other than, perhaps glancing at a purchase total and then an iris scanner. The resulting scanned biometric information then acts as both a *selector* and an authenticator to *retrieve* appropriate charging information to

a charging terminal, which may be implemented via a conventional credit card terminal. Hence, considering the significant benefits afforded by use of the invention as claimed and the fact that the invention has neither been implemented nor anticipated, the invention is clearly not obvious.

Omission of an Element

Unlike the present invention, which does not require a user interface other than a biometric scanner at the point of sale, Mitchell requires a POS terminal with controls to enable a user to select accounts and enter PINs, etc. [0048]-[0050]. Embodiments of the present invention omit such an interface at the point of sale, the interface of which must be navigated via relatively complicated menus and would likely delay checkout lines. Accordingly, the invention as claimed is not obvious in view of Mitchell.

Request That Subsequent Action Not Be Final If New Art Is Cited (per MPEP 706.07(a))

Applicant asserts that all modifications to the claims by this Amendment are reasonable. Note that no new limitations or mechanisms (limitations that were not already present or implied in the Claims) were added. Consequently, such amendments should not necessitate citation of additional references. Accordingly, if Examiner cites additional art in the subsequent Office Action, Applicant requests that the action not be made final per MPEP 706.07(a) (¶ 3) to enable Applicant time to respond to the additional references. Furthermore, since Applicant is seeking to define Applicant's invention in claims that will give applicant justly entitled patent protection, prosecution should not be prematurely cut off (MPEP 706.07).

Request for Assistance Pursuant to MPEP 707.07(j)

Since the claims define novel matter that produces new, unexpected, not suggested, and unanticipated results as described above, Applicant submits that such

claims are clearly patentable. Therefore, it is submitted that patentable subject matter is present. If Examiner agrees that Applicant has presented patentable material but does not feel that the present claims are technically adequate, Applicant respectfully requests that Examiner write acceptable claims or provide corresponding suggestions pursuant to MPEP 707.07(j).

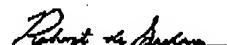
Conclusion

None of the references cited by Examiner taken alone or in combination teaches, discloses, or suggests the invention as presently claimed. For example, none of the references shows a system that can employ biometric information to automatically provide or send an account number to a charging terminal (Claim 1) or to automatically select and deliver an account number to a charging terminals in response to receipt of the biometric information (Claim 3).

The present Application is believed to be in proper form for allowance. Accordingly, allowance, and passage to issue are respectfully requested.

I hereby certify that this correspondence is either being transmitted to the United States Patent and Trademark Office at 571-273-8300 or is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450, on April 10, 2006.

Respectfully submitted,



Robert de Sylva

Applicant Pro Se

Robert de Sylva
161 Ocean Park Blvd. #D
Santa Monica, CA 90405